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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,726	09/07/2000	Christer Alstermark	3525-94	6282

7590 05/20/2003

Nixon & Vanderhye  
1100 North Glebe Road 8th Floor  
Arlington, VA 22201

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 05/20/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/623,726

Applicant(s)

ALSTERMARK et al.

Examiner

Brenda Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 20, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 24-39 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17, 18, 24, 25, 35-37, and 39 is/are rejected.
- 7) ☒ Claim(s) 16, 26-34, and 38 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### **DETAILED ACTION**

Claims 1-18 and 24-39 are pending in the application.

This action is in response to applicants' amendment dated February 20, 2003. Claims 1 and 25-35 have been amended.

#### ***Response to Arguments***

Applicants' arguments filed February 20, 2003 have been fully considered with the following effect:

1. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112 second paragraph rejection labeled i), maintained in the last office action, which is hereby **withdrawn**.
2. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112 first paragraph rejection of claims 1-18, 24 and 39 of the last office action, which is hereby **withdrawn**.
3. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112 second paragraph rejections of claims 1-18, 24, 33 and 29 of the last office action, which are hereby **withdrawn**.
5. With regards to the 35 U.S.C. § 103 obviousness rejection of claims 1-15, 17, 18, 24, 25, 35-37 and 39 over Lubisch et al., U.S. Patent No. 4,959,373 in the last office action, the

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applicant's arguments have been fully considered but are not found persuasive. The applicants stated that "every compound specifically disclosed in Lubisch is based upon 7-benzyl or 7-(4-chlorobenzyl)-3,7-diazabicyclo-[3.3.1]octane (see Examples 1-37 of that document) one of ordinary skill in the art would expect that the presence of an optionally substituted benzyl group at the 7-position of the 3,7-diazabicyclo-[3.3.1]octane ring is essential to the provision of antiarrhythmic compounds". The applicants further stated that the "compounds are explicitly excluded from the scope of Claim 1 (see proviso (a) at page 109, lines 9-10 of the application as filed)".

While it is noted that proviso (a) in Claim 1 excludes compounds where  $R^7$  is an optionally substituted aryl when  $-B-C(R^5)(R^6)-A-$  form a  $-CH_2-$  moiety, the proviso does not exclude the compounds of formula I in U.S. '373 when  $-B-C(R^5)(R^6)-A-$  forms a  $C_2-C_4$ -alkylene. Applicants are respectfully requested to note that all disclosures of a prior art reference must be considered in determining obviousness. See *In re Lamberti*, 192 USPQ 278; *In re Mills*, 176 USPQ 196; *In re Burkel*, 201 USPQ 67. Therefore, while the species of Lubisch do not directly read on the instant claims, there is no obligation on patentee to prepare each and every variant disclosed and claimed because this would impose an undue burden. Thus, the instant  $Ph-C_2-C_4$ -alkylene substituted 3,7-diazabicyclo-[3.3.1]octane compounds being taught as equivalent to those disclosed in Lubisch have been placed in possession of the public. Absent a showing of patentable distinctness the obviousness rejection of claims 1-15, 17, 18, 24, 25, 35-37 and 39 is herein maintained.

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4. The applicants' amendments and arguments are sufficient to overcome the obviousness-type double patenting rejection of the last office action, which is hereby **withdrawn**.

#### *Claim Objections*

5. Claims 16, 26-34 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays from 8:30 AM to 5:00 PM, on Tuesdays from 8:00 AM to 4:30 PM, on Wednesday thru Friday from 9:00 AM to 5:30 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink that reads "Brenda Coleman". The signature is fluid and cursive, with the first letters of the first and last names being capitalized and prominent.

Brenda Coleman  
Primary Examiner AU 1624  
May 19, 2003